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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of
Michael R. Schramm

Serial No.: 09/867,320

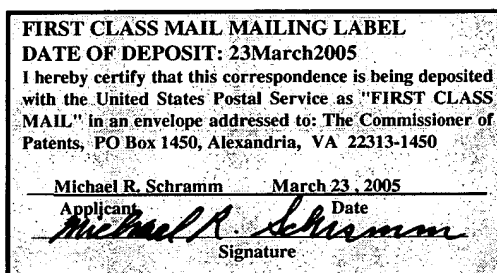
Filed: May 29, 2001

For: Fluid Powered Bubble Machine
With Spill-Proof Capability

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§ Group Art Unit 3751
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§ Examiner: Steven O.
§ Douglas
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§

APPEAL BRIEF

Commissioner of Patents
and Trademarks
Washington, D.C. 20231



Dear Sir:

Pursuant to 37 CFR § 1.192, Appellant submits this Appeal Brief in triplicate to the Board of Patent Appeals and Interferences in support of his appeal from the decision dated October 01, 2004 of the Examiner rejecting claims 36-41 of the captioned application. Applicant notes that this appeal brief is identical to the appeal brief submitted on December 27, 2004 except that this appeal brief includes underlining of new claims 36-41 as required per MPEP 1454 as noted in the examiner's "Notification of Non-Compliant Appeal Brief" dated February 25, 2005. Applicant requests that Applicant's appeal brief fee transmitted on December 27, 2004 and March 15, 2004 be applied to Applicant's current appeal brief fee. Appellant submits that the Examiner erred in rejecting the claims, and respectfully requests reversal of the rejection.

(1) **Real Party in Interest**

The real party in interest is Michael R. Schramm.

(2) **Related Appeals and Interferences**

Appellant is unaware of any pending appeal or interference which affects this appeal.

(3) **Status of Claims**

Claims 1-20 are allowed and claims 36-41 are pending and on appeal. Claims 21-35 have been cancelled.

(4) **Status of Amendments**

The appealed claims have been finally rejected. There has been no amendment filed subsequent to the final rejection of the claims.

(5) **Summary of Invention**

The present invention is summarized in the specification on page 3, left hand column, lines 31 through 56 and is depicted in the drawings in figures 1 through 5 as facilitated by the reference characters listed in the feature table on page 4 of the specification. The present invention relates to a spill-resistant bubble creation device that both automatically creates bubbles and emits amusing streams of water. The invention has particular application for use by young children in creating streams of water and simultaneously creating bubbles without the mess otherwise associated with convention spillable bubble devices.

(6) **Issues**

The issue on appeal is whether or not claims 36-41 have under 35 USC § 251 been filed outside of the two year statutory period.

(7) **Grouping of Claims**

The groups of claims 36-41 should be separately considered. Claim 36 stands or falls alone, claim 37 stands or falls alone, claim 38 stands or falls alone, claim 39 stands or falls alone, claim 40 stands or falls alone, and claim 41 stands or falls alone. The six groups of claims do not stand or fall together.

(8.1) **Argument 1, Claim 36 was erroneously rejected under 35 USC § 251 – Diligence in Filing:**

Appellant respectfully points out that the six groups of claims 36-41 are separately patentable due to the different subject matter claimed in each claim. Specifically, the claims vary in scope and claimed subject matter due to the different limitations of container shape, bubble creation device type

and geometry, and actuation means. Due to these substantial patentably distinct limitations, each group is seen as being separately patentable and each group of claims is seen as standing or falling separately.

Appellant respectfully traverses the Examiners argument that Appellant's application is a broadening reissue application filed outside the two year statutory period. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant's application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

“No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”.

Therefore, in order to satisfy 35 USC § 251 fourth paragraph, an applicant must file his application within two years of the issue date of the “original” patent. Applicant respectfully points out that Applicant's current application is a reissue application of US patent 5,908,057 which issued on June 1, 1999. Applicant's reissue application was filed on May 29, 2001. Inasmuch as May 29, 2001 is less than two years after June 1, 1999, Applicant's respectfully asserts that Applicant's reissue application complies with the requirements of 35 USC § 251 for a broadening reissue application.

In his rejection, the examiner has cited an earlier patent (US 5,832,969) that is one of several included in the chain of pendency of the “genealogy” of Applicant's current application. Accordingly, Applicant assumes that the examiner's interpretation of the word “original” differs from that of Applicant's interpretation. Applicant suggests that absent a law or statute providing interpretation otherwise, that the word original must be given it's normal meaning which in this case would be the original patent that the reissue seeks to correct. Accordingly Applicant respectfully submits that the Office Action rejection is an improper application of 35 USC § 251.

More specifically, the rejection appears to hinge on the interpretation of the term “original patent” in 35 USC 251. The Office Action appears to interpret the term “original patent” as referring to the *parent* of the patent on which a reissue has been applied. However, the remaining text of 35 USC 251 makes clear that the term “original patent” refers only to the patent on which a reissue application has been filed.

35 USC § 251 begins by stating that “any patent” is subject to reissue if it is defective, provided that “such patent” is surrendered when the reissue patent is granted. The statute then uses the terms “original patent” and “new and amended application” to distinguish between the patent on which the reissue is being sought (the “original patent”) from the reissue application filed on that original patent (“the new and amended application”). Thus, the term “original patent” is not being used to refer to a parent application or any other related application, but rather to the very patent on which a reissue has been filed. In the present application, a reissue application was filed on US 5,908,057, issued from 09/021,617. As such, the “original patent” for purposes of 35 USC § 251 is US 5,908,057. As explained above, as the present application was filed within two years of the grant of US 5,908,057, the present application satisfies the two year statutory requirement.

Applicant further notes that the use of the term “original patent” was used as far back as the 1928 version of the Patent Act, which was long before continuation practice was codified in the 1952 Patent Act. Thus, it seems highly unlikely that the term “original patent” was used in the reissue statute as far back as 1928 to distinguish from a continuation patent when such continuation patents were not yet authorized by statute (although were permissible in common law).

Applicant has been unable to find any other application of 35 USC § 251 that is consistent with the application of 35 USC § 251 present in the Office Action. To the contrary, the interpretation of 35 USC § 251 advocated in the Office Action is contrary to District Court interpretations of the term “original patent,” the Board of Patent Appeals and Interferences use of the term “original patent,” the actions of the Federal Circuit, and the actions of numerous other examiners at the PTO.

A. District Court

In *United States Filter Corporation et. al. v. Ionics Corporation*, a Federal District Court in 68 F.Supp2d 48 (copy of entire case enclosed) interpreted the term “original patent” as that term is used in 35 USC § 251. There, the Court interpreted “original patent” to refer to the patent on which a reissue application was filed – similar to the present application where the original patent is US 5,908,057. The case deals with the issue of the defendant asserting that the patentee was trying to recapture something given up in prosecution in the parent application as opposed to the patent from which the

reissue was filed. In this case, the court stated that “original” is the patent from which the reissue was filed, not the parent patent. Specifically, on page twenty of the ruling, the court stated that “... no good reason exists to interpret the word “original” in the § 251 of the Patent Act to mean anything other than its common-sense meaning; the “original” patent is the patent that is corrected by the reissue patent”. The court went on to explain that in analyzing the reissue patent, the court need only look to the “original” patent, the patent that was corrected by reissue, and not to any of the other patents in the reissue patent’s “family tree”.

B. Similarly Situated Patents

A cursory search of the USPTO database has uncovered a number of instances in which a Reissue application was granted, where the reissue was filed on a continuation patent within two years of the grant of the continuation patent but outside of two years of the grant of the parent patent. See for instance:

- RE38,180, filed Jul. 15, 2003
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C. Federal Circuit

In *In Re Doyle*, 293 F.3d 1355, 63 USPQ.2d 1161 (2002), the Federal Circuit addressed an instance in which a broadening reissue application was filed within two years of issuance of a divisional patent, yet outside of two years of issuance of the parent of the divisional patent. While the case focuses on the applicability of an *Orita*-type rejection, at no time was a rejection made that the reissue application was filed outside of the two-year statutory timeframe. This was true despite the fact that the Examiner clearly recognized the close relationship of the reissue claims and the parent patent claims -- one of the grounds on which the Examiner rejected the reissue claims was based on an obviousness-type double patenting rejection over the claims of the parent patent. Id. at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In

Doyle, the Federal Circuit ultimately rejected the pending Orita-type rejection and remanded for further proceedings consistent with the opinion.

(8.2) Argument 2, Claim 37 was erroneously rejected under 35 USC § 251 – Diligence in Filing:

Appellant respectfully traverses the Examiners argument that Appellant's application is a broadening reissue application filed outside the two year statutory period. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant's application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

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In his rejection, the examiner has cited an earlier patent (US 5,832,969) that is one of several included in the chain of pendency of the “genealogy” of Applicant's current application. Accordingly, Applicant assumes that the examiner's interpretation of the word “original” differs from that of Applicant's interpretation. Applicant suggests that absent a law or statute providing interpretation otherwise, that the word original must be given it's normal meaning which in this case would be the original patent that the reissue seeks to correct. Accordingly Applicant respectfully submits that the Office Action rejection is an improper application of 35 USC § 251.

More specifically, the rejection appears to hinge on the interpretation of the term “original patent” in 35 USC 251. The Office Action appears to interpret the term “original patent” as referring to the *parent* of the patent on which a reissue has been applied. However, the remaining text of 35

USC 251 makes clear that the term “original patent” refers only to the patent on which a reissue application has been filed.

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Applicant further notes that the use of the term “original patent” was used as far back as the 1928 version of the Patent Act, which was long before continuation practice was codified in the 1952 Patent Act. Thus, it seems highly unlikely that the term “original patent” was used in the reissue statute as far back as 1928 to distinguish from a continuation patent when such continuation patents were not yet authorized by statute (although were permissible in common law).

Applicant has been unable to find any other application of 35 USC § 251 that is consistent with the application of 35 USC § 251 present in the Office Action. To the contrary, the interpretation of 35 USC § 251 advocated in the Office Action is contrary to District Court interpretations of the term “original patent,” the Board of Patent Appeals and Interferences use of the term “original patent,” the actions of the Federal Circuit, and the actions of numerous other examiners at the PTO.

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The case deals with the issue of the defendant asserting that the patentee was trying to recapture something given up in prosecution in the parent application as opposed to the patent from which the reissue was filed. In this case, the court stated that “original” is the patent from which the reissue was filed, not the parent patent. Specifically, on page twenty of the ruling, the court stated that “... no good reason exists to interpret the word "original" in the § 251 of the Patent Act to mean anything other than its common-sense meaning; the "original" patent is the patent that is corrected by the reissue patent”. The court went on to explain that in analyzing the reissue patent, the court need only look to the “original” patent, the patent that was corrected by reissue, and not to any of the other patents in the reissue patent’s “family tree”.

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patenting rejection over the claims of the parent patent. *Id.* at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In *Doyle*, the Federal Circuit ultimately rejected the pending Orita-type rejection and remanded for further proceedings consistent with the opinion.

(8.3) Argument 3, Claim 38 was erroneously rejected under 35 USC § 251 – Diligence in Filing:

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Applicant further notes that the use of the term “original patent” was used as far back as the 1928 version of the Patent Act, which was long before continuation practice was codified in the 1952 Patent Act. Thus, it seems highly unlikely that the term “original patent” was used in the reissue statute as far back as 1928 to distinguish from a continuation patent when such continuation patents were not yet authorized by statute (although were permissible in common law).

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grounds on which the Examiner rejected the reissue claims was based on an obviousness-type double patenting rejection over the claims of the parent patent. *Id.* at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In *Doyle*, the Federal Circuit ultimately rejected the pending Orita-type rejection and remanded for further proceedings consistent with the opinion.

(8.4) Argument 4, Claim 39 was erroneously rejected under 35 USC § 251 – Diligence in Filing:

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Applicant has been unable to find any other application of 35 USC § 251 that is consistent with the application of 35 USC § 251 present in the Office Action. To the contrary, the interpretation of 35 USC § 251 advocated in the Office Action is contrary to District Court interpretations of the term “original patent,” the Board of Patent Appeals and Interferences use of the term “original patent,” the actions of the Federal Circuit, and the actions of numerous other examiners at the PTO.

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A cursory search of the USPTO database has uncovered a number of instances in which a Reissue application was granted, where the reissue was filed on a continuation patent within two years of the grant of the continuation patent but outside of two years of the grant of the parent patent. See for instance:

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C. Federal Circuit

In *In Re Doyle*, 293 F.3d 1355, 63 USPQ.2d 1161 (2002), the Federal Circuit addressed an instance in which a broadening reissue application was filed within two years of issuance of a divisional patent, yet outside of two years of issuance of the parent of the divisional patent. While the case focuses on the

applicability of an *Orita*-type rejection, at no time was a rejection made that the reissue application was filed outside of the two-year statutory timeframe. This was true despite the fact that the Examiner clearly recognized the close relationship of the reissue claims and the parent patent claims -- one of the grounds on which the Examiner rejected the reissue claims was based on an obviousness-type double patenting rejection over the claims of the parent patent. *Id.* at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In *Doyle*, the Federal Circuit ultimately rejected the pending *Orita*-type rejection and remanded for further proceedings consistent with the opinion.

(8.5) Argument 5, Claim 40 was erroneously rejected under 35 USC § 251 – Diligence in Filing:

Appellant respectfully traverses the Examiners argument that Appellant's application is a broadening reissue application filed outside the two year statutory period. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant's application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

“No reissue patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.”.

Therefore, in order to satisfy 35 USC § 251 fourth paragraph, an applicant must file his application within two years of the issue date of the “original” patent. Applicant respectfully points out that Applicant's current application is a reissue application of US patent 5,908,057 which issued on June 1, 1999. Applicant's reissue application was filed on May 29, 2001. Inasmuch as May 29, 2001 is less than two years after June 1, 1999, Applicant's respectfully asserts that Applicant's reissue application complies with the requirements of 35 USC § 251 for a broadening reissue application.

In his rejection, the examiner has cited an earlier patent (US 5,832,969) that is one of several included in the chain of pendency of the “genealogy” of Applicant's current application. Accordingly, Applicant assumes that the examiner's interpretation of the word “original” differs from that of Applicant's interpretation. Applicant suggests that absent a law or statute providing interpretation otherwise, that the word original must be given it's normal meaning which in this case would be the

original patent that the reissue seeks to correct. Accordingly Applicant respectfully submits that the Office Action rejection is an improper application of 35 USC § 251.

More specifically, the rejection appears to hinge on the interpretation of the term “original patent” in 35 USC 251. The Office Action appears to interpret the term “original patent” as referring to the *parent* of the patent on which a reissue has been applied. However, the remaining text of 35 USC 251 makes clear that the term “original patent” refers only to the patent on which a reissue application has been filed.

35 USC § 251 begins by stating that “any patent” is subject to reissue if it is defective, provided that “such patent” is surrendered when the reissue patent is granted. The statute then uses the terms “original patent” and “new and amended application” to distinguish between the patent on which the reissue is being sought (the “original patent”) from the reissue application filed on that original patent (“the new and amended application”). Thus, the term “original patent” is not being used to refer to a parent application or any other related application, but rather to the very patent on which a reissue has been filed. In the present application, a reissue application was filed on US 5,908,057, issued from 09/021,617. As such, the “original patent” for purposes of 35 USC § 251 is US 5,908,057. As explained above, as the present application was filed within two years of the grant of US 5,908,057, the present application satisfies the two year statutory requirement.

Applicant further notes that the use of the term “original patent” was used as far back as the 1928 version of the Patent Act, which was long before continuation practice was codified in the 1952 Patent Act. Thus, it seems highly unlikely that the term “original patent” was used in the reissue statute as far back as 1928 to distinguish from a continuation patent when such continuation patents were not yet authorized by statute (although were permissible in common law).

Applicant has been unable to find any other application of 35 USC § 251 that is consistent with the application of 35 USC § 251 present in the Office Action. To the contrary, the interpretation of 35 USC § 251 advocated in the Office Action is contrary to District Court interpretations of the term “original patent,” the Board of Patent Appeals and Interferences use of the term “original patent,” the actions of the Federal Circuit, and the actions of numerous other examiners at the PTO.

A. District Court

In *United States Filter Corporation et. al. v. Ionics Corporation*, a Federal District Court in 68 F.Supp2d 48 (copy of entire case enclosed) interpreted the term “original patent” as that term is used in 35 USC § 251. There, the Court interpreted “original patent” to refer to the patent on which a reissue application was filed – similar to the present application where the original patent is US 5,908,057. The case deals with the issue of the defendant asserting that the patentee was trying to recapture something given up in prosecution in the parent application as opposed to the patent from which the reissue was filed. In this case, the court stated that “original” is the patent from which the reissue was filed, not the parent patent. Specifically, on page twenty of the ruling, the court stated that “... no good reason exists to interpret the word "original" in the § 251 of the Patent Act to mean anything other than its common-sense meaning; the "original" patent is the patent that is corrected by the reissue patent”. The court went on to explain that in analyzing the reissue patent, the court need only look to the “original” patent, the patent that was corrected by reissue, and not to any of the other patents in the reissue patent’s “family tree”.

B. Similarly Situated Patents

A cursory search of the USPTO database has uncovered a number of instances in which a Reissue application was granted, where the reissue was filed on a continuation patent within two years of the grant of the continuation patent but outside of two years of the grant of the parent patent. See for instance:

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C. Federal Circuit

In *In Re Doyle*, 293 F.3d 1355, 63 USPQ.2d 1161 (2002), the Federal Circuit addressed an instance in which a broadening reissue application was filed within two years of issuance of a divisional patent, yet

outside of two years of issuance of the parent of the divisional patent. While the case focuses on the applicability of an *Orita*-type rejection, at no time was a rejection made that the reissue application was filed outside of the two-year statutory timeframe. This was true despite the fact that the Examiner clearly recognized the close relationship of the reissue claims and the parent patent claims -- one of the grounds on which the Examiner rejected the reissue claims was based on an obviousness-type double patenting rejection over the claims of the parent patent. *Id.* at 1357-58. The proper remedy in that situation, as noted by the Federal Circuit in FN4, is simply the filing of a terminal disclaimer. In *Doyle*, the Federal Circuit ultimately rejected the pending *Orita*-type rejection and remanded for further proceedings consistent with the opinion.

(8.6) Argument 6, Claim 41 was erroneously rejected under 35 USC § 251 – Diligence in Filing:

Appellant respectfully traverses the Examiners argument that Appellant's application is a broadening reissue application filed outside the two year statutory period. Applicant does not dispute the assertion by the examiner that the submitted claims are broaden claims. However, Applicant asserts that Applicant filed Applicant's application within the two year statutory period. Applicant notes that 35 USC § 251 fourth paragraph reads as follows:

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More specifically, the rejection appears to hinge on the interpretation of the term "original patent" in 35 USC 251. The Office Action appears to interpret the term "original patent" as referring to the *parent* of the patent on which a reissue has been applied. However, the remaining text of 35 USC 251 makes clear that the term "original patent" refers only to the patent on which a reissue application has been filed.

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(9) **Appendix**

The following are the claims involved with this appeal.

36. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container wherein said container defines at least one container of the following group of containers comprising a container defining an inner cavity of a predetermined length and having an open funnel extending into said cavity and wherein said funnel is at least half as long as said length of said cavity, a container defining an inner cavity and having a open funnel extending into said cavity said funnel having an inner opening and wherein said inner opening is substantially centrally located within said cavity, a container defining an inner cavity and having a substantially rectangular shaped open funnel and wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position, and a container defining an inner cavity having an open non-cylindrical/non-conical funnel and wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position.
37. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device defines at least one bubble creation device of the following group of bubble creation devices comprising a bubble creation device having a plurality of bubble orifices, a bubble creation device defining a bubble wheel having at least one bubble orifice, and a bubble creation device having a first portion and a second portion and wherein said first portion includes at least one bubble orifice and wherein said second portion defines a portion that remains within said funnel when a bubble is created.
38. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container defining an inner cavity having a first opening wherein said first opening includes a open funnel connected to said first opening and extending into said cavity and wherein said container includes a second opening having an opening cover removeably

connected to said second opening and wherein said bubble creation device is mechanically actuateable into and out of said container.

39. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device defines a bubble creation device having at least one substantially planer bubble orifice defining a plane and wherein said bubble creation device is moveable into and out of said container by moving along a path through said funnel, and wherein said path through said funnel defines an axis, and wherein said axis lies substantially within said orifice plane when said bubble orifice moves through said funnel.
40. A non-cavitation bubble creation apparatus comprising a bubble creation device and a container having an inner cavity and an open funnel extending into said cavity wherein said container resists spillage of a predetermined amount of liquid contents of said container when said container is oriented in any position and wherein said bubble creation device is movably connected to said container and wherein said bubble creation device is mechanically actuateable into and out of said container.
41. A non-cavitation bubble creation apparatus comprising a bubble creation device having at least one bubble orifice of a predetermined length and a container having an inner cavity and an open funnel of a predetermined length extending lengthwise into said cavity and wherein said length of said funnel exceeds said length of said orifice.

(10) **Conclusion**

In view of the comments above, it is submitted the Examiner erred in rejecting the claims on appeal. Appellant therefore respectfully requests that this Honorable Board reverse the Examiner's rejection of the claims. If the Board has any questions or comments which may be resolved over the telephone, the board is requested to call Michael R. Schramm at 801-625-9268 (wk) or at 435-734-2599 (hm).

DATE: March 23, 2005

Respectfully submitted,

A handwritten signature in cursive script that reads "Michael R. Schramm". The signature is written in dark ink and is positioned above a horizontal line.

Michael R. Schramm

Please address all correspondence in connection with this application to: Michael R. Schramm
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Perry, UT 84302
Wk Ph (801) 625-9268
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